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JUL 26 2010

OFFICE OF PETITIONS

In re Application of	:	
Martin	:	
Application No. 09/830,972	:	
International Filing Date: November 5, 1999	:	DECISION ON PETITION
Attorney Docket No. 68323 (302934)	:	
For: Nucleotide and Protein Sequences of	:	
Nogo Genes and Methods Based Thereon	:	

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Petition for Review of Patent Term Adjustment Under 37 CFR §§ 1.181 & 1.705(b)" received on September 25, 2009.

The petition under 37 CFR 1.705 is dismissed.

The petition under 37 CFR .1.181 is dismissed.

Background

Petitioner notes that the Notice of Allowance mailed on June 26, 2009, for the above-identified application stated that the Patent Term Extension is 0 days and did not contain an indication of patent term adjustment. Petitioner asserts that the above identified national phase patent application, which was filed on May 2, 2001 should be accorded Patent Term Adjustment. Petitioner asserts that the correct Patent Term Adjustment is 296 days, on the basis of the 391 days of Office delay and 95 days of reduction.

Petitioner asserts that it appears the Office used the International filing date of the application November 5, 1999 to determine whether or not the application was eligible for patent term adjustment. Petitioner states that the Office has "indicated that to be eligible for PTA, the international filing date must have an international filing date of May29, 2000 or later. See 4405(a) of the AIPA, 35 USC § 363, and 37 CFR § 1.702(f)." Petitioner cites:

35 USC § 363 states that an international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a

national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title. (Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392.)

Petitioner states that "in contrast, the wording of 35 U.S.C. § 154(b)(1)(B) . . . indicates that Congress used the phrase "actual filing date" for the purpose of patent term adjustment to be the date the national stage application commenced under 35 U.S.C. 371 (b) or (f) from an international application".

Petitioner states that "consistent with the use of an "actual filing date" in the United States for determining patent term adjustments, the Office measures the three year pendency provision in 35 U.S.C. 154(b)(1)(B) from the date that the national stage commences under 35 U.S.C. 371 (b), as well as 35 U.S.C. 371 (b)(f) in an international application. See Exhibit B entitled "Notice Concerning Calculation of the Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) involving International Applications Entering the National Stage Pursuant to 35 U.S.C. § 371" (signed 09 September 2009)" Thus, Petitioner asserts that the application should be entitled to PTA based on the actual filing date under 35 U.S.C. 371 under either section (b) or (f).

Petitioner elects the date of September 24, 2009¹, under 35 U.S.C. 371(f). Petitioner asserts that since the filing date is after May 28, 2000, that the application is eligible for PTA. Petitioner asserts that the Patent Term Adjustment should be two hundred and ninety six (296) days. Petitioner asserts that there were three hundred and ninety one (391) days of Office delay and ninety five (95) days of applicant delay, which count as a reduction.

Opinion

35 U.S.C. § 154(b) (as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000. 35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000).

The above-identified application was filed on November 5, 1999. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

¹ Petition page 5, item 24.

The filing date of a PCT international application is the date applicant satisfies Article 11 requirements, i.e., includes a description, a claim, names at least one applicant who is a resident or national of a PCT Contracting State, filed in the prescribed language, and designates at least one Contracting State. See MPEP § 1810. By virtue of 35 U.S.C. 363, the U.S. filing date of an international application that designates the United States is, for most legal purposes, the international filing date. See MPEP § 1893.03(b).

Petitioner's assertion that the application is eligible for patent term adjustment provisions pursuant to 35 U.S.C. § 154 and 37 CFR 1.702 - 1.705 because the Office measures the three year pendency provision in 35 U.S.C. 154(b)(1)(B) from the date that the national stage commences under 35 U.S.C. 371(b), as well as 35 U.S.C. 371(f), when the statute uses the term "actual filing date", thus to be consistent, the date the national stage commences is the filing date is not persuasive. In accordance with 35 U.S.C. § 363, an international application which designates the United States has the effect from its international filing date of a national application filed in the Office. The effective date provision (§ 4405) in the legislation clearly states that the amendments to 35 U.S.C. § 154 apply to applications filed on or after the date that is 6 months after the date of enactment, i.e., May 29, 2000. This provision does not include applications that were filed prior to the date of enactment or even immediately after the date of enactment, but applications that were filed on or after the date that is 6 months after the date of enactment, see *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*, 65 FR 56366 (Sept. 18, 2000) 1239 Off Gaz. Pat. Office Notices 14 (Oct. 3, 2000).²

The delay in the allowance and issuance is regrettable, but the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. § 41 (a)(7). The required \$200 fee for the petition under 37 CFR 1.705(b) petition has been paid.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



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Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

² Sykes v. Dudas, 573 F.Supp 2d 191, 89 USPQ2d 1423 (D.D.C.2008).